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Docket No. RSW920010164US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leslie et al.

Group Art Unit: 3629

Filed: 8/17/2001

Examiner: Smith, Traci L.

Serial No.: 09/932,163

**Title: CUSTOMIZING THE PRESENTATION OF INFORMATION TO SUIT A USER'S
PERSONALITY TYPE**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This petition is being filed in response to the Final Office Action dated May 9, 2005.

Petition Under 37 CFR § 1.181(a)(1)

Applicants hereby petition for withdrawal of the finality of the Final Office Action dated May 9, 2005 on grounds that the finality of the Final Office Action dated May 9, 2005 is procedurally improper. Applicants' authorized representative, Jack P. Friedman, discussed this issue with Examiner Traci L. Smith in a telephone conversation on 05/26/2005. In said telephone conversation, Examiner Smith maintained her position that the finality of the Final Office Action dated April 23, 2003 is procedurally proper. As a result, Applicants are filing this petition to resolve this issue since Applicants' authorized representative has unsuccessfully attempted to resolve this issue through direct communication with the Examiner. Since prosecution of the above-mentioned patent application is not being stayed pending the decision on this petition,

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Applicants respectfully request a timely decision resulting from this petition.

Procedural Facts

The originally filed patent application comprised claims 1-10. A first Office Action was mailed 12/07/2004 to which Applicant filed a response on 03/07/2005.

In the Office Action mailed 12/07/2004, claims 1-2 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Breese et al. (US Patent 5,987,415).

In Applicant's response filed 03/07/2005 Applicant amended the claims as follows: original claims 1-2 were not amended, original claims 3-10 were canceled, and new claims 11-29 were added.

A Final Office Action was mailed 05/09/2005. In the Final Office Action mailed 05/09/2005, claims 1-2 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Gerace, "Method for Determining Behavioral Profile of a Computer User".

Issue

Whether the Final Office Action rejection mailed 05/09/2005 should have instead been a non-final Office Action.

Argument

As stated in MPEP §706.07(a) "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information

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submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." (emphasis added).

In the Final Office Action rejection mailed 04/23/03, Examiner Smith stated: "Applicant's amendment necessitated the new ground(s) of rejection presented in this office action".

In response, Applicant respectfully maintains that Applicant's amendment did not necessitated the new ground of rejection of claims 1-2, since claims 1-2 were not amended in Applicant's response filed 03/07/2005.

Accordingly, the Final Office Action rejection mailed 05/09/2005 should have instead been a non-final Office Action, based on MPEP §706.07(a).

Summary

In summary, Applicants respectfully petition for withdrawal of the finality of the Final Office Action dated May 9, 2005. Since prosecution of the present patent application is not being stayed pending the decision on this petition, Applicants respectfully request a timely decision resulting from this petition.

The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

Date: 05/26/2005

Schmeisor, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, New York 12110
(518) 220-1850

Jack P. Friedman
Jack P. Friedman
Registration No. 44,688

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